

**Re.** : Amendment and Response to Office Action Mailed July 1, 2005  
**Appl. No.** : 09/228,325  
**Filed** : January 11, 1999

## **II. REMARKS**

Claims 1, 2, 5-18 and 44-53 are currently pending and the Office Action rejected Claims 1, 2, 5-18 and 44-53. By the foregoing amendments, Applicant has amended Claims 1, 14, 45, 46 and 48 to further clarify, broaden and/or define the claimed invention, and expedite receiving a notice of allowance. Pursuant to 37 C.F.R. § 1.121(f), no new matter is introduced by these amendments. As discussed in greater detail below, Applicant believes that Claims 1, 2, 5-18 and 44-53 are now in condition for allowance.

### **A. Response to the Claim Objection**

The Office Action objected to Claim 45 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Office Action stated that the acrylic backboard is already claimed in Claim 44.

Applicant respectfully thanks the Examiner for his careful review of the application. In order to overcome this claim objection under 37 C.F.R. § 1.75(c), Applicant amended Claim 45 to provide “wherein the basketball backboard frame is constructed from metal.” In view of this amendment, Applicant requests that this objection to Claim 45 be withdrawn.

### **B. Response to the Section 112 Rejection**

The Office Action stated that Claims 46-49 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action states

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the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office Action states that although Claims 46 and 48 have the term “catalyzed polymeric adhesive,” the specification fails to mention or define this term or show what the meets and bounds of the term is. The Office Action further stated that Claim 47 inherits the deficiency of Claim 46 and Claim 49 inherits the deficiency of Claim 48.

Applicant respectfully traverses this rejection because the specification describes the term “catalyzed polymeric adhesive” in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. However, in order to further clarify, broaden and/or define the claimed invention, and expedite receiving a notice of allowance, Applicant amended Claims 46 and 48 to provide a “catalyzed elastomeric adhesive.” Accordingly, Applicant requests that this Section 112 rejection of Claims 46-49 be withdrawn.

**C. Response to the First Section 103(a) Rejection**

The Office Action rejected Claims 1, 2, 5, 6, 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over applicant’s admitted prior art in view of United States patent no. 6,056,622 issued to Chung; U.S. patent no. 3,809,401 issued to Hankele; U.S. patent nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.; and Dow Corning Data Sheet Q3-6093. The Office Action stated that Applicant stated that the use of double sided adhesive tape to attach backboards to a frame structure

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is old (page 2, lines 3-17). The Office Action also stated that Applicant admits that the use of double sided tape was inadequate in that it was costly and time consuming (page 2, lines 9-14). The Office Action stated that a workman in the art in view of this deficiency would have looked for other equivalent but better means of attachment in the sporting goods adhesive art.

Briefly, the Office Action asserts that the workman would have noted the art of the Chung, Hankele and Skedleski patents because each of which provide similar equivalent adhesive attachment means for sporting goods. In particular, the Office Action states that the Chung patent discloses that the “attachment of sports articles can be secured by suitable and conventional means” which includes using “silicone glue.” Page 4, lines 29-30. The Office Action states the Hankele patent discloses the use of any of the adhesives known in the art, such as “epoxy or silicone adhesives.” Page 2, lines 34-37. The Office Action also states that the ‘316 Skedleski patent discloses using a “suitable means of attachment such as silicone adhesive” and using a primer to improve adhesion. Page 1, lines 46-49, 61-64. The Office Action further states the ‘314 Skedleski patent discloses the desirability of the silicon adhesive having a cushioning effect. Page 2, lines 60-64.

The Office Action asserts that the art of the Chung, Hankele and Skedleski patents clearly shows that those knowledgeable in the sporting goods adhesion art were aware of silicon adhesives and their suitability and advantages when considering cost, cushioning and superior adhesive qualities where sporting goods will be used in severe conditions such as outdoors.

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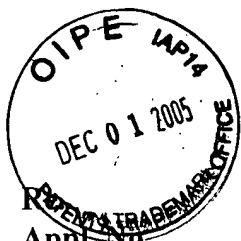
The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a silicone adhesive as taught by the Chung, Hankele or Skedleski patents in order to lower production costs and manufacture a more durable backboard in order to increase the player's satisfaction with the product. The Office Action also asserts that it would have been obvious to one of ordinary skill in the art to have sought and selected the most suitable adhesive from among the equivalent silicone adhesives available including Dow Q3-6093 by the routine optimization expected by one of skill in the art (citing In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960)). The Office Action stated that it should be noted that no unexpected or extraordinary results were obtained by Applicant in using the silicone adhesive. The Office Action asserts that Applicant was merely following the recommended procedure for using the adhesive.

Applicant respectfully traverse this rejection because neither Claims 1, 2, 5, 6, 14 or 15 are disclosed, taught or suggested by the Chung, Hankele and Skedleski patents or the Dow Corning Data Sheet Q3-6093, either alone or in combination.

**1. U.S. Patent No. 6,056,622 issued to Chung**

In contrast to the Examiner's assertion, the Chung patent does **not** disclose that the "attachment of sports articles can be secured by suitable and conventional means" which includes using "silicone glue." Instead, the Chung patent discloses:

The **parts of ball part 60** are thereafter **secured together by suitable and conventional means, such as an adhesive like clear silicone glue with a chemical**



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**composition, methoxy polydimethylsiloxane, which is thereafter allowed to cure  
about one day and at room temperature.**

Col. 4, lines 28-32 (emphasis added).

In greater detail, the Chung patent discloses a ball with unpredictable bounce characteristics. In particular, the Chung patent states the ball part 60 comprises a ball of the high bouncing type, such as ball 30 of Figure 1. Col. 3, lines 65-67. The Chung patent explains:

Ball part 30 comprises a **conventional high bouncing type ball** of the type that might also be utilized to play, practice or train with for **baseball**. Ball part 30 is made of an **elastic rubber** (silicone, thermoplastic elastomer, or the like) and is referred to an high bouncing because when dropped from a height of 149 cm onto a marble floor, ball 30 will rebound at about 112 cm.

Col. 3, lines 21-27 (emphasis added).

Thus, the Chung patent discloses a conventional high bouncing type ball that may be used to play baseball and is constructed from elastic rubber. The Chung patent also discloses that parts of the elastic rubber, high bouncing type ball may be secured together using an adhesive like clear silicone glue, which is allowed to cure about one day and at room temperature. Therefore, the Chung patent teaches using an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball.

In contrast, Claim 1 is directed towards a basketball backboard assembly including a rigid frame and a rigid acrylic backboard, neither of which is constructed from elastic rubber. In addition,

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Claim 1 positively recites “a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Chung patent, on the other hand, discloses using an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball. The Chung patent does **not** teach, suggest or disclose either (1): using clear silicone glue to adhere two separate, rigid members, such as a backboard frame and an acrylic backboard; or (2) that the silicone glue will provide sufficient adhesion and flexibility to an acrylic backboard and frame structure that will allow it to be used in the game of basketball. Accordingly, the Chung patent does **not** teach, suggest or disclose each and every element of Claim 1.

**2. U.S. Patent No. 3,809,401 issued to Hankele**

The Hankele patent discloses a hockey stick with a flexible net for catching and stopping a puck in both the forehand and backhand position. Col. 1, lines 41-43. In particular, the Hankele patent states that the hockey stick includes a handle 12, a blade 14 and a net 16. The Hankele patent also states “[a] rod 18 extends across the elbow between the handle 12 and the blade 14. Rod 18 has one end 20 that is secured in a hole adjacent the toe 22 of blade 14. A second end 24 of the rod is secured in a hole in handle 12. The ends 20 and 24 are secured in place by a pressed fit, or if desired, an adhesive can be used to additionally secure the ends in place.” Col. 2, lines 12-18 (emphasis added). The Hankele patent further states “[t]he net 16 has an upper edge that is secured to the rod

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18. This securement is accomplished by forming loops 26 in the top strands of the net, and adhesively securing these loops to the rod 18.” Col. 2, lines 23-26 (emphasis added). Additionally, the Hankele patent states “[t]he net also includes free ends 28 which are secured in holes in the handle 12 and blade 14. The free ends 28 are adhesively secured in place within the holes.” Col. 2 lines 26-29 (emphasis added). The Hankele patent states “[t]he rod 18, the loops 26 and the ends 28 of the net 16 can be adhesively secured in place by any of the adhesives known in the art, such as epoxy or silicone adhesives.” Col. 2, lines 34-37 (emphasis added).

Accordingly, the Hankele patent discloses that adhesives known in the art, such as epoxy or silicone adhesives, may be used to: (1) additionally secure the ends of a rod 18 that are press fit into a hole in the toe of the blade and into a hole in the handle of a hockey stick; (2) adhesively secure loops 26 in the top strands of a net 16 to the rod 18; and (3) adhesively secure the free ends 28 of the net 16 in holes in the handle 12 and blade 14. Therefore, the Hankele patent teaches using adhesives that are known in the art, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, secure loops in the top of a net to a rod, and secure the free ends of the net into holes in the hockey stick.

Claim 1, on the other hand, positively recites, inter alia, “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Hankele patent does

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**not** teach, suggest or disclose, for example, a catalyzed elastomeric adhesive sandwiched between a frame bonding surface and a backboard bonding surface, or an elastomeric adhesive that provides sufficient adhesion and flexibility to an acrylic backboard and frame structure bonding surface to be used in the game of basketball. Accordingly, the Hankele patent does **not** teach, suggest or disclose each and every element of Claim 1.

**3. U.S. Patent Nos. 4,792,316 and 4,955,314 issued to Skedleski, et al.**

The Skedleski patents are directed towards a safety tip of a water sport board, such as a surf board, for reducing or preventing injury to a user upon impact with the nose portion of the board. For example, the '316 patent states "a surfboard tip cover is provided which comprises a generally hollow, substantially V-shaped member which is made of a relatively soft, flexible and resilient silicone material." Col. 1, lines 33-37 (emphasis added). The '316 patent also states "[t]he tip cover is preferably constructed of a flexible and resilient liquid injected silicone." Thus, the Skedleski patents are directed towards a relatively soft, flexible and resilient silicone material that is used that is used as a safety device.

The Skedleski patents also state that "[t]he tip cover is fixedly secured to the top portion of the board, for example, by silicone adhesive between the body portion and the extension portions and the parts of the board that they overlay." Col. 1, lines 55-59 of the '314 patent. The '316 patent states that "[i]t is preferable that any space left between the tip of the board and the apex of the cover be filled with the silicone adhesive to provide an even further cushioning effect." Col. 2, lines 59-63.



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Thus, the Skedleski patents disclose using a silicone adhesive to attach the relatively soft, flexible and resilient silicone tip cover to the sharply pointed nose of a water sport board. The Skedleski patents also disclose that any space between the tip of the board and the apex of the cover may be filled with silicone adhesive to provide an even further cushioning effect. Therefore, the Skedleski patents disclose using a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board as a safety device.

In contrast, Claim 1 is directed towards a basketball backboard assembly including a rigid frame and a rigid acrylic backboard, neither of which is constructed from a relatively soft, flexible and resilient silicone material. Additionally, Claim 1 positively recites, inter alia, “a backboard frame structure having a bonding surface; an acrylic backboard having a bonding surface; and a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” The Skedleski patents do **not** teach, suggest or disclose, for example, a catalyzed elastomeric adhesive sandwiched between a frame bonding surface and an acrylic backboard bonding surface. In addition, the Skedleski patents do **not** teach suggest or disclose an elastomeric adhesive that provides sufficient adhesion and flexibility to an acrylic backboard and frame structure bonding surface to be used in the game of basketball. Accordingly, the Skedleski patents do **not** teach, suggest or disclose each and every element of Claim 1.

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**4. Claims 1, 2, 5, 6, 14 and 15 are NOT Obvious in View of the Cited References**

Applicant respectfully traverses this rejection because none of the cited references, either alone or in combination, teach, suggest or disclose each and every limitation of Claims 1, 2, 5, 6, 14 or 15. For example, none of the cited references disclose a basketball backboard assembly sized and configured for playing the game of basketball. In contrast, the cited references disclose a ball with an unpredictable bounce, a hockey stick, and a water sport board safety tip. Because none of the references teach, suggest or disclose a basketball backboard assembly sized and configured for playing the game of basketball, Applicant requests that this Section 103 (a) rejection of Claims 1, 2, 5, 6, 14 and 15 be withdrawn.

In addition to none of the cited references teaching, suggesting or disclosing a basketball backboard assembly sized and configured for playing the game of basketball, none of the cited references teach, suggest or disclose either a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface. In fact, none of the cited references disclose any type of basketball related structures or are even used in connection with basketball. Thus, Applicant requests that this Section 103 (a) rejection of Claims 1, 2, 5, 6, 14 and 15 be withdrawn because none of the references, either alone or in combination, teach, suggest or disclose a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface.

In addition to none of the cited references teaching, suggesting or disclosing a basketball backboard assembly sized and configured for playing the game of basketball, a backboard frame structure having a bonding surface or an acrylic backboard having a bonding surface; none of the

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cited references teach, suggest or disclose a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface or an elastomeric adhesive providing sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball. As discussed above, none of the cited references are used in connection with basketball. In contrast, the references are directed towards: (1) an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball (the Chung patent); (2) using adhesives that are known in the art, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, secure loops in the top of a net to a rod, and secure the free ends of the net into holes in the hockey stick (the Hankele patent); and (3) using a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board as a safety device (the Skedleski patents). Because none of the references teach, suggest or disclose a catalyzed elastomeric adhesive sandwiched between the frame bonding surface and the backboard bonding surface or the elastomeric adhesive providing sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball, Applicant requests that this Section 103 (a) of Claims 1, 2, 5, 6, 14 and 15 rejection be withdrawn.

There is also no suggestion that any of the cited references can be properly combined to support this Section 103 (a) rejection. The courts have made clear that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination. See, e.g., ACS Hospital Systems, Inc.

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v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). In this case, there is no teaching, suggestion or incentive to combine an adhesive like clear silicone glue to secure together parts of an elastic rubber, high bouncing type ball; an adhesive, such as epoxy or silicone adhesives, to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and/or a safety device that uses a silicone adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board. Accordingly, Applicant requests that this Section 103 (a) rejection of Claims 1, 2, 5, 6, 14 and 15 be withdrawn because there is no teaching, suggestion or incentive supporting the combination of these references.

Furthermore, the cited references **teach away** from Claim 1 which positively recites “a catalyzed elastomeric adhesive that is sandwiched between the frame bonding surface and the backboard bonding surface, wherein the elastomeric adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surface to be used in the game of basketball.” For example, the cited references disclose using: (1) an adhesive to secure together parts of an elastic rubber, high bouncing ball; (2) an adhesive to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and (3) an adhesive to attach a relatively soft, flexible and resilient silicone material to the hard, sharp point of a water sports board. Thus, the cited references teach using an adhesive to connect **different materials** for **different purposes** than the claimed basketball backboard assembly. Therefore, because the cited references **teach away** from the invention recited

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in Claim 1, Applicant requests that this Section 103 (a) rejection be withdrawn.

In summary, neither the Chung, Hankele or Skedleski patents, nor the Dow Corning Data Sheet Q3-6093, either alone or in combination, teach, suggest or disclose each and every limitation recited in Claim 1. In addition, independent Claim 14 is patentable in view of the cited references at least because it includes limitations similar to those discussed above in connection with Claim 1. Further, Claims 2, 5, 6 and 15 are also patentable in view of the cited references at least because these claims are dependent upon independent Claims 1 and 14 respectively.

**5. Secondary Considerations of Non-obviousness Confirm Claims 1, 2, 5, 6, 14 and 15 are Patentable in View of the Cited References**

In addition to Claims 1, 2, 5, 6, 14 and 15 not being obvious in view of the cited art, the secondary considerations of nonobviousness confirm that the claimed invention is not obvious.<sup>1</sup> As stated in the MPEP:

**Objective evidence or secondary considerations such as unexpected results, commercial success, longfelt need, failure of others, copying by others, licensing, and skepticism of experts** are relevant to the issue of obviousness and **must be considered in every case** in which they are present. When evidence of any of these secondary considerations is submitted, **the examiner must evaluate the evidence.**<sup>2</sup>

Such secondary considerations may serve to “establish that [the] invention appearing to have been obvious in light of the prior art was not.”<sup>3</sup> In fact, evidence of commercial success may be so strong

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<sup>1</sup> See MPEP § 716.01(a) at 700-255 (8th ed. rev. 2 2004) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983)).

<sup>2</sup> See MPEP § 2141 at 2100-121 (8th ed. rev. 2 2004).

<sup>3</sup> *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498 (Fed. Cir. 1986), *cert. dismissed*, 483 U.S. 1052 (1987).

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that it requires a reversal of a decision that the teachings of the prior art would have suggested the claimed invention to one of ordinary skill in the art.<sup>4</sup> Here, the secondary considerations of commercial success and copying by others confirm that the invention is not obvious.

**a. The Claimed Invention has Enjoyed Great Commercial Success**

In his declaration, Mr. Jerry Ward explained that the Assignee Lifetime Products has had great commercial success selling the claimed invention. Mr. Ward stated:

As Manager of Boards, Silk Screen, and Materials, I am aware of the materials and manufacturing costs associated with fabricating acrylic basketball backboards. Lifetime products saves approximately \$3 per backboard in material costs for each acrylic backboard fabricated using catalyzed elastomeric adhesive instead of conventional two-sided tape. **In the year 2000, Lifetime Products manufactured approximately 300,000 acrylic backboard basketball systems.** This represents a materials cost savings of about \$900,000. **In the year 2001, Lifetime Products is projected to manufacture approximately 400,000 acrylic backboard basketball systems.**<sup>5</sup>

Thus, in 2000, Assignee Lifetime Products manufactured about 300,000 acrylic backboards using catalyzed elastomeric adhesive to attach the acrylic backboard to the frame. In 2001, Assignee Lifetime Products was projected to manufacture about 400,000 such acrylic backboards. The selling of approximately 700,000 acrylic backboards using catalyzed elastomeric adhesive to attach the acrylic backboard to the frame in a two year period demonstrates definite commercial success. This strong evidence of commercial success shows that the prior art would not have suggested the claimed

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<sup>4</sup> See *Simmons Fastener Corp. v. Illinois Tool Works, Inc.*, 739 F.2d 1573, 1577 (Fed. Cir. 1984), *cert. denied*, 471 U.S. 1065 (1985).

<sup>5</sup> Ward Decl. ¶ 11, dated August 31, 2001 (Filed with an Amendment and Response to Office Action mailed on September 11, 2001).

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invention to one of ordinary skill in the art.

**b. Commercial Success is Based At Least in Part on the Significant Material and Labor Costs Savings Caused by the Claimed Invention**

Mr. Ward also explained that the claimed invention has resulted in significant reductions in the costs of materials for each basketball backboard constructed using a catalyzed elastomeric adhesive:

As Manager of Boards, Silk Screen, and Materials, I am aware of the materials and manufacturing costs associated with fabricating acrylic basketball backboards. **Lifetime products saves approximately \$3 per backboard in material costs for each acrylic backboard fabricated using catalyzed elastomeric adhesive instead of conventional two-sided tape.** In the year 2000, Lifetime Products manufactured approximately 300,000 acrylic backboard basketball systems. **This represents a materials cost savings of about \$900,000.** In the year 2001, Lifetime Products is projected to manufacture approximately 400,000 acrylic backboard basketball systems. **This represents a materials cost savings of about \$1,200,000.**<sup>6</sup>

Thus, Assignee Lifetime Products saved approximately \$2,100,000 in material costs during the two year period of 2000-01.

Mr. Ward further explained that using the claimed invention over the conventional two-sided tape resulted in a labor savings of about 62.5%:

There are very significant labor savings when acrylic backboards are fabricated using catalyzed elastomeric adhesive. Using twelve (12) people in three shifts, about 2400 acrylic backboards may be fabricated per day using the catalyzed elastomeric adhesive process. In contrast, twenty-four (24) people in three shifts are required to

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<sup>6</sup> Ward Decl. ¶ 11, dated August 31, 2001 (Filed with an Amendment and Response to Office Action mailed on September 11, 2001).

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fabricate 1800 acrylic backboards using the conventional two-sided tape system. This represents labor savings of about 62.5%.<sup>7</sup>

Thus, by employing embodiments of the claimed invention, the Assignee had great commercial success, significant reductions in materials costs, and a tremendous savings in labor costs.

**c. Others Have Copied the Claimed Invention**

Huffy Sports is a direct competitor of Lifetime Products, the assignee of this application, and sells basketball backboards. As discussed below, Huffy Sports copied the claimed invention after Assignee Lifetime Products began selling its backboard and enjoying its great commercial success.

**1. In 1999, after Six Years of Using the Conventional Double-Side Tape Systems, Assignee Began Using the Claimed Invention**

Mr. Ward explained that Lifetime Products, the assignee of the present application, began using the conventional double-sided tape systems in 1993:

Lifetime Products began manufacturing and selling acrylic basketball backboards in 1993 using two-sided foam tape to secure acrylic basketball backboards to a backboard frame.<sup>8</sup>

Mr. Nye added that Lifetime Products began selling embodiments of the claimed invention in October 1999:

In October 1999, Lifetime Products began selling acrylic basketball backboards fabricated with elastomeric adhesive to bond the acrylic backboard to the frame.

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<sup>7</sup> Ward Decl. ¶ 12 (August 31, 2001).

<sup>8</sup> Ward Decl. ¶ 3 (August 31, 2001).



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Prior to this, Lifetime Products used double-sided tape to fabricate acrylic basketball backboards.<sup>9</sup>

**2. In 2001, Huffy Sports Copied the Claimed Invention**

In his declaration, Mr. S. Curtis Nye explained how Huffy Sports previously used the conventional double-sided tape systems: “Huffy Sports utilized double-sided tape to bond the acrylic backboard to the frame.”<sup>10</sup>

Mr. Nye then explained that in 2001, Lifetime Products learned that Huffy had switched to using the claimed invention:

Lifetime Products recently became aware of two commercially available acrylic basketball backboards manufactured by Huffy Sports, a division of Huffy Corporation, that utilize an elastomeric adhesive to bond the acrylic backboard to the frame. These are a metal frame unit, model number 9H909, and a blow molded frame unit, model 74069. Lifetime Products purchased these products for evaluation in July and August 2001. *Prior to this time*, Huffy Sports utilized double-sided tape to bond the acrylic backboard to the frame.<sup>11</sup>

Thus, the claimed invention has been copied by others.

**c. The Secondary Considerations Establish the Claimed Invention is Not Obvious**

Here, the secondary considerations of nonobviousness confirm that the claimed invention is not obvious. For example, the claimed invention has enjoyed great commercial success by selling millions of dollars of product within a two year period. In addition, the claimed invention has

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<sup>9</sup> Nye Decl. ¶ 2 (August 31, 2001).

<sup>10</sup> Nye Decl. ¶ 3 (August 31, 2001).

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resulted in significant cost and labor savings. Further, the claimed invention was promptly copied by other so that they could enjoy some of the commercial success, material costs savings and reduction in labor caused by the claimed invention.

In summary, the claimed invention is not obvious because Lifetime Products and Huffy Sports both used conventional double-sided tape systems for years. However, once Lifetime Products developed the claimed invention, it immediately enjoyed commercial success and significant savings in both material and labor costs. Huffy Sports then promptly copied the claimed invention. Accordingly, the secondary considerations of nonobviousness confirm that the claimed invention is not obvious. Consequently, Applicant requests that the Section 103 (a) rejection of Claims 1, 2, 5, 6, 14 and 15 be withdrawn.

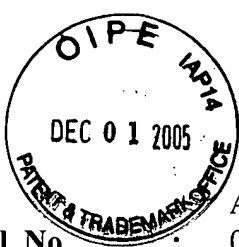
**D. Response to the Other Section 103(a) Rejections**

The Office Action also rejected Claims 44-53 in view of the Claim 1 rejection discussed above. Claims 2, 5, 6, 8-10, 11, 12, 13, 14, 15, 16-18, 50-53 were also rejected under Section 103(a).

Applicant respectfully traverses this rejection because none of the cited references, either alone or in combination, teach, suggest or disclose each and every element of the claims. For example, as discussed above, none of the cited references, either alone or in combination, teach, suggest or disclose each and every element of Independent Claims 1 or 14. For similar reasons, none of the cited references, either alone or in combination, teach, suggest or disclose each and every

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<sup>11</sup> Nye Decl. ¶ 3 (August 31, 2001) (emphasis added).



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element of independent Claims 44, 46, 48, 50 or 52. Accordingly, Applicant respectfully requests that the rejection of independent Claims 44, 46, 48, 50 or 52 be withdrawn. Additionally, at least because Claims 2, 5, 6, 8-10, 11, 12, 13, 15, 16-18, 45, 47, 49, 51 and 53 are dependent upon Claims 1, 14, 44, 46, 48, 50 or 52, Applicant requests that this Section 103(a) rejection of Claims 2, 5, 6, 8-10, 11, 12, 13, 14, 15, 16-18, 50-53 be withdrawn.

**E. Prior Decision By the Board of Patent Appeals and Interferences Held that the Claimed Invention was Not Obvious in View of Similar References**

On March 27, 2003, the Board of Patent Appeals and Interferences reversed the April 11, 2001 final rejection, which relied primarily upon U.S. patent no. 5,839,982 issued to Hying, et al., and an adhesive from Dow Corning.<sup>12</sup> Briefly, the Board explained how it found no teaching or suggestion (not even an inference) that would have motivated one of ordinary skill in the art to use the Dow Corning® adhesive to attach Hying's basketball backboard and basketball frame:

Like appellant, *we find no teaching, suggestion, or inference* in the combined teachings of the applied references that would have led the ordinarily skilled artisan *to utilize the adhesive of Dow Corning to secure the acrylic backboard of Hying to the backboard frame*, as proposed by the examiner. The examiner's position to the effect that it would have been an "obvious choice" for one of ordinary skill in the art to use any readily available and suitable adhesive, and in particular the adhesive of Dow Corning, as a replacement for Hying's double-sided adhesive is without foundation in the absence of evidence supporting such contention. *More particularly, the examiner has not pointed out where the applied references teach that using Dow Corning's adhesive in Hying's environment would "prevent injury to the player," and/or precisely what "properties over wide temperature ranges"*

<sup>12</sup> See *Ex parte* Stevens, 4-5, 9 (Bd. Pat. App. & Inter. March 27, 2003) [Paper No. 26].

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***Dow Corning's adhesive possesses that the one of ordinary skill in the art would have found to be "desirable" in Hying's environment.***<sup>13</sup>

Thus, no reference taught or suggested the Dow Corning® adhesive could be used in the Hying patent's particular "environment" of attaching its basketball backboard to its basketball frame. Accordingly, without the proper teaching or suggestion, it was improper to hold that it was obvious to use the Dow Corning® adhesive in the particular context of attaching a basketball backboard to a basketball frame.

In addition, the Board stated that Hying disclosed "a known prior basketball backboard construction wherein a double-sided adhesive layer 5 is used to secure an acrylic backboard 3 to a welded steel frame 1" and also stated that Hying criticized that particular design.<sup>14</sup> Nevertheless, the Board held that it was not obvious to use any particular adhesive to attach a basketball backboard to a basketball frame -- without any guidance to pick a particular adhesive:

In a nutshell, *the examiner appears to take the position that it would have been obvious to try any number of prior art adhesives until one possibly arrived at a successful result where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful.* However, *this is not the standard* of 35 U.S.C. § 103.<sup>15</sup>

The Office Action dated July 1, 2005 also fails to cite any references that teach, suggest or disclose using a particular adhesive in the relevant context of attaching a basketball backboard to a basketball frame. Thus, the reasoning of the Board also applies to the references cited in the July 1,

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<sup>13</sup> See *Ex Parte Stevens*, at 6-7 (emphasis added).

<sup>14</sup> See *Ex Parte Stevens*, at 4-5 (footnote omitted).

<sup>15</sup> See *Ex Parte Stevens*, at 6-7 (citations omitted) (emphasis added).

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2005 Office Action. For example, the Chung Patent, the Hankele Patent, the Skedelecki Patents, and the Dow Corning® datasheet, either alone or in combination, would not teach, suggest, or disclose to one of ordinary skill in the art to attach a basketball backboard to a basketball frame in any manner (and certainly not with any particular adhesive) because none of them individually discuss attaching a basketball backboard and a basketball frame.

Additionally, although the Dow Corning® datasheet states that its adhesive is “[d]eveloped for a variety of high technology bonding, sealing and encapsulating applications,” the Dow Corning® datasheet never recommends, suggests, teaches, or describes attaching a basketball backboard to a basketball frame as a particular use. Further, the Dow Corning® datasheet never even mentions the sport of basketball. Thus, as the Board has already decided, the Dow Corning® datasheet does not provide any teaching, suggestion, or motivation for attaching a basketball backboard to a basketball frame and, thus, cannot be properly be combined with basketball backboard prior art.<sup>16</sup>

Also, the Office Action assumes that the Applicant has simply used an adhesive in the manufacturer’s “recommended way.” With this assumption, the Office Action expresses concern that “[i]f one were to follow this logic to its natural end, the sales representative for the acrylic adhesive should be added to the inventors of the application since he/she brought necessary knowledge to the inventive process.” The Office Action’s assumption is false because the Dow Corning® datasheet does not recommend using its adhesive to attach a basketball backboard and

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<sup>16</sup> See *Ex Parte Stevens*, at 6-7.

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basketball frame.

The Office Action allows improperly relies on impermissible hindsight to assert that the claimed invention is obvious. The Office Action states “The applicant also admits that the use of double side tape was inadequate in that it was costly and time consuming.” The Office Action then reasons: “A workman in the art in view of this deficiency would have looked for other equivalent but better means of attachment in the adhesive art.” However, as explained by the Applicant in the Application, **the double-side tape is deficient when compared to the Applicant’s invention.**<sup>17</sup>

Under the Office Action’s approach, any invention that is less expensive and/or faster to manufacture than the prior art would necessarily provide a “motivation” to look for ways to improve that prior art.

It is not surprising that the MPEP directs against such hindsight analysis: “The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.”<sup>18</sup>

Because the Office Action necessarily relies upon a hindsight comparison of the claimed invention to the prior art, Applicant requests that this Section 103(a) rejection be withdrawn.

Furthermore, the cited references teach away from using an adhesive to attach a basketball backboard and a basketball frame. For example, the cited references teach (1) an adhesive to secure together parts of an elastic rubber, high bouncing ball; (2) an adhesive to further secure the ends of a rod into holes in a hockey stick, to secure loops in the top of a net to a rod, and to secure the free ends of the net into holes in the hockey stick; and (3) an adhesive to attach a relatively soft, flexible

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<sup>17</sup> *cf.* Ward Decl. ¶ 11 (August 31, 2001) (discussing material cost savings); Ward Decl. ¶ 12 (August 31, 2001) (discuss labor time/cost savings).

<sup>18</sup> See MPEP § 2141 at 2100-120 (8th ed. rev. 2 2004).

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and resilient silicone material to the hard, sharp point of a water sports board. Thus, the cited references teach using an adhesive to connect different materials for different purposes than attaching a basketball backboard and a basketball frame. Therefore, teach away from attaching a basketball backboard and a basketball frame.

### CONCLUSION

In view of the foregoing, Applicant submits that Claims 1, 2, 5-18 and 44-53 are allowable over the cited references and are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be promptly issued.

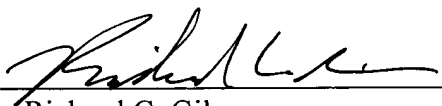
If any further impediments to allowance of this application remain, the Examiner is cordially invited to contact the undersigned by telephone so that these remaining issues may be promptly resolved.

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The Commissioner is authorized to charge payment of any additional fees associated with this communication, which have not otherwise been paid, to Deposit Account No. 23-3178. If any additional extension of time is required, which have not otherwise been requested, please consider this a petition therefore and charge any additional fees that may be required to Deposit Account No. 23-3178.

Respectfully submitted,

Dated: 12-1-05

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